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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,617	04/16/2004	Bruce Forest	P/4553-3	1315
2352 7590 11/18/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
KUCAB, JAMIE R				
ART UNIT		PAPER NUMBER		
3621				
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11/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,617

Applicant(s)

FOREST, BRUCE

Examiner

JAMIE KUCAB

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's response filed July 24, 2008 is acknowledged.
2. Claims 1-21 are pending in the application. Claims 10-21 are withdrawn from consideration.
3. This Office action is given Paper No. 20081112 for reference purposes only.
4. Based on a comparison of the PGPub 2004/0210538 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Restrictions

5. Claims 10-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 24, 2008.

Election of Species

6. The Applicant elected species B **without** traverse in the reply filed July 24, 2008. Applicant identified claims 18 and 19 as readable on the elected species B, but claims 18 and 19 are withdrawn as being drawn to a nonelected invention (see paragraph 5 above). The Examiner finds that claims 1-9 are generic to species A and B. Therefore,

the election of species requirement is withdrawn and claims 1-9 are being examined on the merits. If Applicant amends such that distinct species are claimed, a further election of species requirement may be made.

Claim Objections

7. Claim 6 is objected to because of the following informalities: where Applicant recites, "Digital Rights Management", it appears that Applicant intends to recite -- digital rights management software -- or similar. For the purpose of comparison with the prior art, the Examiner is taking it as such. Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "metadata" in claim 1 is used by the claim to mean "data attached

to or embedded in other data", while the accepted meaning is "Data about data. For example, the title, subject, author, and size of a file constitute meta data about the file."¹ The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3 and 6-9, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Meyer et al. (U.S. Pat. No. 7,188,186, hereafter "Meyer").

13. Regarding claim 1, Meyer discloses a method for making multimedia content available to consumers, the method comprising:

- a. accessing the multimedia content ("original pre-prepared media file," C2 L60 - C3 L3);

¹ Microsoft Press Computer Dictionary, 3rd ed. Redmond, Washington, Microsoft Press, 1997. pg. 305. QA76.15.M54 1997.

- b. encoding the multimedia content in a format for distribution ("Encoding Process," Fig. 1 and associated text; "embedding," C2 L60 - C3 L3);
 - c. providing a package ("Media File with Embedded Executable Code") comprising the encoded multimedia content ("Media File") and metadata ("Executable Code," Fig. 1, "supplemental digital program content," Abstract);
 - d. electronically distributing the package ("content distribution," C6 L6-13);
 - e. permitting the consumers to copy the electronically distributed package to a copied package; and permitting the consumers to distribute the copied package (inherent - as evidenced by the lack of mention of content protection of any type and the disclosure of "simplifying content distribution" (C6 L12-13) and "advertiser-sponsored music files ... enabling the subsidizing of music distribution" (C4 L55-63); further, it is inherent because even copy-protected files can be copied and distributed).
14. Regarding claim 2, Meyer further discloses wherein the multimedia content is at least one of a song, audio recording, television programs recording, film, video video-game and software application ("the 'Paint it Black' song," C4 L40-54).
15. Regarding claim 3, Meyer further discloses wherein the format is mp3 ("MP3," C4 L40-54).
16. Regarding claim 6, Meyer further discloses wherein the metadata does not comprise Digital Rights Management (inherent - as evidenced by the lack of any content protection mechanism associated with any of the disclosed embodiments; as further evidenced by the disclosure of "simplifying content distribution" (C6 L12-13) and

"advertiser-sponsored music files ... enabling the subsidizing of music distribution" (C4 L55-63)).

17. Regarding claim 7, Meyer further discloses wherein the metadata comprises an advertisement ("The content may be, but is not limited to, advertising, ..." C5 L37-49).

18. Regarding claim 8, Meyer further discloses providing the metadata while the multimedia content is playing (Fig. 1a, C4 L55-64; Fig. 1c, "enabling fully transactional ads and merchandising directly to the listener at the playback apparatus," C5 L3-12).

19. Regarding claim 9, Meyer further discloses wherein the metadata is provided in at least one of a text display device, a video graphic display device, and an audio device (Fig. 1a).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1-9, as understood by the Examiner, are rejected under 35

U.S.C. §103(a) as being unpatentable over Meyer in view of Examiner's Official Notice.

22. It is the Examiner's principle position that claims 1-3 and 6-9 are anticipated as above because lack of digital rights management is inherent in Meyer. However, if not inherent, the Examiner takes Official Notice that it is old and well known in the art to allow consumers to copy and distribute multimedia files in order to avoid the expense

and/or time of digital rights management or where other considerations such as advertising or marketing outweigh the need to protect content from being freely distributed. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Meyer to include the copying and distributing of Examiner's Official Notice in order to reach the widest audience by efficiently and inexpensively disseminating electronic multimedia content and avoiding the complexities both to consumer and provider of digital rights management.

23. Regarding claim 4, Meyer discloses all the elements of the claimed invention. But Meyer fails to explicitly disclose wherein the step of distributing the package further comprises uploading the package to at least one of a top site, FTP site, Usenet site or Internet Relay Chat site. However, the Examiner takes Official Notice that it is old and well known in the art to distribute through any one of a top site, FTP site, Usenet site or IRC site because distribution to such sites increases diffusion of the distributed file more quickly than distribution at other sites. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Meyer to include the distribution step of Examiner's Official Notice in order to rapidly disseminate a piece of content to as large a number of potential viewers as possible.

24. Regarding claim 5, Meyer discloses all the elements of the claimed invention. But Meyer fails to explicitly disclose uploading the package to at least one of an Internet web site pertaining to a consumer goods company, a particular good or service, and a musical artist. However, the Examiner takes Official Notice that it is old and well known in the art to upload content to web sites as this is an inexpensive and efficient way to

distribute files, as it requires a low overhead compared to "bricks and mortar" retail distribution of content. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Meyer to include the uploading step of Examiner's Official Notice in order to cost-effectively distribute the supplemental content to a wide audience.

Examiner Note

25. The Examiner has cited particular columns, line, and/or paragraph numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider a reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

26. Any Official Notices taken by the Examiner that are not adequately traversed by Applicant will be taken to be admitted prior art.
27. The following are examples of recitations that have been considered but given less patentable weight because they fail to add any steps/structure and are thereby regarded as intended use language:

"permitting the consumers to copy the electronically distributed package to a copied package" in claims 1,

"permitting the consumers to distribute the copied package" in claim 1.

To be especially clear, the Examiner has considered all claim limitations. However, the recitation of intended use of the claimed invention must result in additional steps/structure in order to further limit the claims. Where possible, in order to advance prosecution, the Examiner has addressed these limitations in anticipation of Applicant amending the claims to positively recite these limitations (-- the consumer copying ... -- or similar).

Conclusion

28. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

29. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

30. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
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